



Exhibit

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark OfficeAddress: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/139,835 10/22/93 MORGAN

W P170

EXAMINER
NGUYEN, K

ART UNIT PAPER NUMBER

3504

DATE MAILED: 09/12/94

THOMAS B. TATE
P.O. BOX 41
SOUTH ST. PAUL, MN 55075

C5M1/0912

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1 is pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1 is rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

Fig(s) _____
Sectional views. 37 CFR 1.84(h)(3)
— Hatching not indicated for sectional portions of an object. Fig(s) _____
— Hatching of regularly spaced oblique parallel lines not spaced sufficiently. Fig(s) _____
— Hatching not at substantial angle to surrounding axes or principal lines. Fig(s) _____
— Cross section not drawn same as view with part in cross section with regularly spaced parallel oblique strokes. Fig(s) _____
— Hatching of juxtaposed different elements not applied in a different way. Fig(s) _____
Alternate position. 37 CFR 1.84(h)(4)
— A separate view required for a moved position. Fig(s) _____

— Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig(s) _____
— View numbers not preceded by the abbreviation Fig. Fig(s) _____
— Single view contains a view number and the abbreviation Fig. Fig(s) _____
— Numbers not larger than reference characters. Fig(s) _____

16. CORRECTIONS. 37 CFR 1.84(w)

— Corrections not durable and permanent. Fig(s) _____

17. DESIGN DRAWING. 37 CFR 1.152

— Surface shading shown not appropriate. Fig(s) _____
— Solid black shading not used for color contrast. Fig(s) _____

ATTACHMENT TO PAPER NO. 2

REVIEWER

W Sale

DATE 11/16/93

Serial Number: 08/139,835

Art Unit: 3504



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Part III DETAILED ACTION

Drawings

1. Fig. 2 is objected to because the welded area (4) between adjacent panel units (1) is not consistent with Fig. 1. Correction is required.

Claim Rejections - 35 USC § 112

2. Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On line 1, the limitation "For a pond cover" is vague because it is not clear what is the meaning of "For".

The limitations on lines 2 and 3 are interpreted as three separate means; however, at the end of line 3, the limitation "said means" is confusing because it is not clear which "means" applicant is referring to.

Line 5, the limitation "at either end and along either side" and "either end" on line 11 are indefinite because since applicant has not limited the shape of the panel unit, therefore it is impossible to determine what are "either end" and "either side" of the panel unit.

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Art Unit: 3504

Line 6, it is not clear whether the limitation "securing means" was the same as means for securing said pond cover on line 3. If they were, then why are they presented twice ?

Allowable Subject Matter

3. Claim 1 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

4. The following is an Examiner's statement of reasons for the indication of allowable subject matter: no prior art of record teaches or fairly suggest, alone or in combination, a cover having a plurality of panel units connected together in vertical spaced relationship at their ends, a plurality of grommets disposed at the connected ends, a cable disposed through each the grommets and formed into a loop projecting above the panel units, and a cable disposed through the entire row of the loops.

Although German patent 2004656 and Bartolucci show many elements similar to applicant's claimed invention such as in panel units (5) filled internally with foam plastics (7) and at least one cable (9) disposed underneath the panel units as illustrated in the drawings of the German patent ('656); grommets (20) at the edges of a pool cover, connectors (21) disposed through the grommets (20) above the cover and a cable (25) disposed through the connectors (21) of Bartolucci, there is no motivation to combine the two references together.

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Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Klauffke et al., Koelsch, Morris, Loff, Hinsperger and Graves show various types of pool cover. Serfling et al. shows a heating-retaining cover (36) for a pond.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kien Nguyen whose telephone number is (703) 308-2493.

KIEN T. NGUYEN
PATENT EXAMINER
GROUP 3504

ktn
September 7, 1994

JUN 13 2001

NOTICE OF DRAFTSPERSON'S PATENT DRAWING REVIEW

PTO Draftspersons review all originally filed drawings regardless of whether they are designated as formal or informal. Additionally, patent Examiners will review the drawings for compliance with the regulations. Direct telephone inquiries concerning this review to the Drawing Review Branch, 703-305-8404.

The drawings filed (insert date) 10/22/93 are

- A. ☒ not objected to by the Draftsperson under 37 CFR 1.84 or 1.152.
 B. ☒ objected to by the Draftsperson under 37 CFR 1.84 or 1.152 as indicated below. The Examiner will require submission of new, corrected drawings when necessary. Corrected drawings must be submitted according to the instructions on the back of this Notice.

1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings:

Black ink. Color.

- ☐ Not black solid lines. Fig(s) _____
☐ Color drawings are not acceptable until petition is granted.

2. PHOTOGRAPHS. 37 CFR 1.84(b)

☐ Photographs are not acceptable until petition is granted.

3. GRAPHIC FORMS. 37 CFR 1.84 (d)

- ☒ Chemical or mathematical formula not labeled as separate figure. Fig(s) _____
☐ Group of waveforms not presented as a single figure, using common vertical axis with time extending along horizontal axis. Fig(s) _____
☐ Individual waveform not identified with a separate letter designation adjacent to the vertical axis. Fig(s) _____

4. TYPE OF PAPER. 37 CFR 1.84(c)

- ☒ Paper not flexible, strong, white, smooth, nonshiny, and durable. Sheet(s) 1-2
☐ Erasures, alterations, overwritings, interlineations, cracks, creases, and folds not allowed. Sheet(s) _____

5. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable paper sizes:

21.6 cm. by 35.6 cm. (8 1/2 by 14 inches)
 21.6 cm. by 33.1 cm. (8 1/2 by 13 inches)
 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches)
 21.0 cm. by 29.7 cm. (DIN size A4)

- ☐ All drawing sheets not the same size. Sheet(s) _____
☐ Drawing sheet not an acceptable size. Sheet(s) _____

6. MARGINS. 37 CFR 1.84(g): Acceptable margins:

Paper size

21.6 cm. X 35.6 cm. (8 1/2 X 14 inches)	21.6 cm. X 33.1 cm. (8 1/2 X 13 inches)	21 cm. X 27.9 cm. (DIN Size A4)
T 5.1 cm. (2")	2.5 cm. (1")	2.5 cm. (1")
L .64 cm. (1/4")	.64 cm. (1/4")	.64 cm. (1/4")
R .64 cm. (1/4")	.64 cm. (1/4")	.64 cm. (1/4")
B .64 cm. (1/4")	.64 cm. (1/4")	.64 cm. (1/4")

Margins do not conform to chart above.

- Sheet(s) _____
☐ Top (T) ☐ Left (L) ☐ Right (R) ☐ Bottom (B)

7. VIEWS. 37 CFR 1.84(h)

REMINDER: Specification may require revision to correspond to drawing changes.

- ☐ All views not grouped together. Fig(s) _____
☐ Views connected by projection lines. Fig(s) _____
☐ Views contain center lines. Fig(s) _____

Partial views. 37 CFR 1.84(h)(2)

- ☐ Separate sheets not linked edge to edge. Fig(s) _____
☐ View and enlarged view not labeled separately. Fig(s) _____
☐ Long view relationship between different parts not clear and unambiguous. 37 CFR 1.84(h)(2)(ii). Fig(s) _____

Sectional views. 37 CFR 1.84(h)(3)

- ☐ Hatching not indicated for sectional portions of an object. Fig(s) _____
☐ Hatching of regularly spaced oblique parallel lines not spaced sufficiently. Fig(s) _____
☐ Hatching not at substantial angle to surrounding axes or principal lines. Fig(s) _____
☐ Cross section not drawn same as view with parts in cross section with regularly spaced parallel oblique strokes. Fig(s) _____
☐ Hatching of juxtaposed different elements not angled in a different way. Fig(s) _____

Alternate position. 37 CFR 1.84(h)(4)

- ☐ A separate view required for a moved position. Fig(s) _____

Modified forms. 37 CFR 1.84(h)(5)

- ☐ Modified forms of construction must be shown in separate views. Fig(s) _____

8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)

- ☐ View placed upon another view or within outline of another. Fig(s) _____
☐ Words do not appear in a horizontal, left-to-right fashion when page is either upright or turned so that the top becomes the right side, except for graphs. Fig(s) _____

9. SCALE. 37 CFR 1.84(k)

- ☐ Scale not large enough to show mechanism without crowding when drawing is reduced in size to two-thirds in reproduction. Fig(s) _____
☐ Indication such as "actual size" or "scale 1/2" not permitted. Fig(s) _____
☐ Elements of same view not in proportion to each other. Fig(s) _____

10. CHARACTER OF LINES, NUMBERS, & LETTERS. 37 CFR 1.84(l)

- ☒ Lines, numbers & letters not uniformly thick and well defined, clean, durable, and black (except for color drawings). Fig(s) 1-2

11. SHADING. 37 CFR 1.84(m)

- ☐ Shading used for other than shape of spherical, cylindrical, and conical elements of an object, or for flat parts. Fig(s) _____
☐ Solid black shading areas not permitted. Fig(s) _____

12. NUMBERS, LETTERS, & REFERENCE CHARACTERS. 37 CFR 1.84(p)

- ☐ Numbers and reference characters not plain and legible. 37 CFR 1.84(p)(1) Fig(s) _____
☐ Numbers and reference characters used in conjunction with brackets, inverted commas, or enclosed within outlines. 37 CFR 1.84(p)(1) Fig(s) _____
☐ Numbers and reference characters not oriented in same direction as the view. 37 CFR 1.84(p)(1) Fig(s) _____
☐ English alphabet not used. 37 CFR 1.84(p)(2) Fig(s) _____
☐ Numbers, letters, and reference characters do not measure at least .32 cm. (1/8 inch) in height. 37 CFR(p)(3) Fig(s) _____

13. LEAD LINES. 37 CFR 1.84(q)

- ☐ Lead lines cross each other. Fig(s) _____
☐ Lead lines missing. Fig(s) _____
☐ Lead lines not as short as possible. Fig(s) _____

14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.84(t)

- ☐ Number appears in top margin. Fig(s) _____
☐ Number not larger than reference characters. Fig(s) _____
☐ Sheets not numbered consecutively, and in Arabic numerals, beginning with number 1. Sheet(s) _____

15. NUMBER OF VIEWS. 37 CFR 1.84(u)

- ☐ Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig(s) _____
☐ View numbers not preceded by the abbreviation Fig. Fig(s) _____
☐ Single view contains a view number and the abbreviation Fig. Fig(s) _____
☐ Numbers not larger than reference characters. Fig(s) _____

16. CORRECTIONS. 37 CFR 1.84(w)

- ☐ Corrections not durable and permanent. Fig(s) _____

17. DESIGN DRAWING. 37 CFR 1.152

- ☐ Surface shading shown not appropriate. Fig(s) _____
☐ Solid black shading not used for color contrast. Fig(s) _____

ATTACHMENT TO PAPER NO. 2

REVIEWER

W. Sale

DATE

11/16/93

Applicant's Copy

EXAMINER'S ACTION

Exhibit

A



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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02/828,330

03/28/97

MORGAN

W

I-852-002

PM82/1019

EXAMINER

CANFIELD, R

ART UNIT

PAPER NUMBER

3635

21

DATE MAILED:

10/19/00

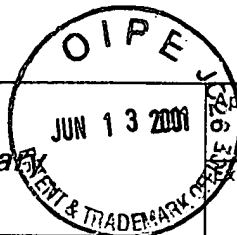
N. PAUL FRIEDERICH
ANDERHEIM LAW FIRM LTD
P.O. BOX 48755
COON RAPIDS MN 55448

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

RECEIVED OCT 27 2000

Office Action Summary



Application No. 08/828,330

Applicant(s) :

Morgan

Examiner

Robert Canfield

Group Art Unit

3635



☒ Responsive to communication(s) filed on Aug 15, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12, 14-16, and 18-48 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-3 is/are allowed.

☒ Claim(s) 4-12, 14-16, and 18-48 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on May 19, 2000 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3635

1. This Office action is in response to the amendments filed 5/19/00 and 8/15/00. Claims 1-12, 14-16 and 18-48 are pending.

2. Claims 4-12, 14-16 and 18-48 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In claim 4 the limitation of the cable disposed through the entire row of loops has been omitted.

In claims 5-12, 14-16 and 18-48 many of the limitations recited in the reasons for allowance have been omitted.

The examiner included these limitations in his reasons for allowance in paper #2 mailed 09/12/94 of the patented file. Applicant failed to present a counter statement or comment as to

Art Unit: 3635

the examiner's reasons for allowance, and permitted the claim to issue. The omitted limitations are thus established as relating to subject matter previously surrendered.

3. Applicant's arguments filed 08/15/00 have been fully considered but they are not persuasive.

Applicant argues that his silence to respond to the examiner's reasons for allowance does not equate to surrender. This is not found persuasive as it is Patent Office policy that failure to present a counter statement or comment as to the examiner's reasons for allowance, and permitting the claims to issue can establish surrender by silence.

4. Claims 1-3 are allowable over the prior art for the same reasons given in the paper #2 dated 09/12/94 of the patented application S.N. 0/139835.

5. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 05/19/00 have been approved.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

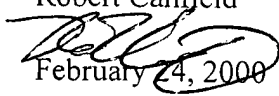
Art Unit: 3635

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Canfield whose telephone number is (703) 308-2482. The examiner can normally be reached on M-Th from 8:30 to 6:00.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Robert Canfield


February 24, 2000

Robert Canfield
Primary Examiner

06-14-01

AF/3621/H



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DMC
#27
4/20/01

Applicant : William D. Morgan

Serial No. : 08/828,330

Filed : 03-28-97

Group Art Unit: 3621

For : INSULATED REMOVABLE
POND COVER

Examiner: R. Canfield

Docket No. : I 852-002-PAT

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Commissioner of Patents and Trademarks
Washington, D. C. 20231

JUN 19 2001

TO 3600 MAIL ROOM

APPEAL BRIEF

(1) **Real Party of Interest:**

The real party of interest is William D. Morgan of Minneapolis, MN the sole inventor.

(2) **Related appeals and interferences:**

There are no other related appeals or interferences.

(3) **Status of the Claims:**

Claims 1 through 3 are allowed.

Claims 4 through 12, 14 through 16, and 18 through 48 are rejected under 35 U.S.C. §
251 as being an impermissible attempt to recapture previously surrendered claim breadth.

(4) **Status of amendments:**

The amendments filed prior to the March 7, 2001 interview and the March 7, 2001 interview have been filed. The Amendment after Final filed March 19, 2001 was not entered.

(5) **Summary of invention:**

An insulated removable pond cover for settling ponds having a plurality of sealed panel units containing insulation. The panels units are linked together by means of a system of cables which interact with grommets in the panel units.

(6) **Issues:**

Whether the non-response of an applicant to an Examiner's dicta should be construed as an intentional surrender of patentable subject matter in the application for which the present reissue is based.

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(7) **Grouping of Claims:**

JUN 13 2001

All of the rejected claims have been rejected under 35 U.S.C. § 251 as being an impermissible attempt to recapture previously surrendered claim breadth and as such may be treated as a single group.

TO 3600 MAIL ROOM

(8) **Argument:**

Claims 4-12, 14-16 and 18-48 were rejected under 35 U.S.C. § 251 as being an improper recapture of claimed subject matter surrendered in the application for the patent upon which the present reissue application is based. Specifically, the present claims are stated to violate the recapture rule. The Current Examiner¹ has rejected the Claims that are the subject of this appeal

¹ The terminology "Current Examiner" refers to the Examiner of the Reissue Application. The term "Previous Examiner" will be used to refer to the Examiner of the Patent.

on the basis that Claims are allegedly an impermissible broadening of the Claims in an attempt to recapture previously surrendered subject matter.² The Previous Examiner in the prosecution of the patent included in his remarks³ the limitations that the Current Examiner alleges were surrendered. This alleged surrender purportedly occurred when the prior attorney was silent to the Previous Examiner's dicta.

The Office Action⁴ states that the broadened subject matter was surrendered in the prior application, citing to *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984); *Hester Indus. Inc. v. Stein, Inc.*, 142 F. 3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); and *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997). Such cases set forth the appropriate analysis.

In considering the "error" requirement, we keep in mind that the reissue statute is based on fundamental principles of equity and fairness and should be construed liberally....One of the commonly asserted "errors" in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original application. This form of error has generally been accepted as sufficient to satisfy the "error" requirement of §251. *Hester* 131 F.3d at 1479-80.

"Under the recapture rule, claims that are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible." *Id.* at 1480. "The first step in applying the recapture rule is to determine whether and in what 'aspect' the reissue claims are broader than the patent claims." *Clement* 131 F.3d at 1468. In the present case, applicant agrees that the claims are broader than the original claim. Clarity on which

² Paper 21, page 2, paragraph 2. Attached as Exhibit "A."

³ Paper 21, page 2, paragraph 2.

⁴ Paper 21.

aspects are in fact broadening is of no import in the present case for the reasons set forth below.

“The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for **arguments and changes to the claims made in an effort to overcome a prior art rejection.**” *Id.* at 1468-69 (citing *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984) (emphasis added)). In all three cases, the act of surrendering was “an overt act on the part of the applicant” in arguing that particular claim limitations in the claims distinguished over the prior art and those limitations were the ones the applicant tried to remove on reissue. *Clement*, 131 F.3d at 1470; *Ball*, 729 F.2d at 1437; and *Hester*, 142 F.3d at 1482.

In the present case, however, we have no cancellation of claims, argument or other file history made in an effort to overcome a prior art rejection. No prior art rejection existed and no surrender occurred.

The Previous Examiner’s rejected the Claim under § 112 second paragraph as being indefinite⁵. Looking at the reasons for the rejection and the Claim of the patent, it is quite clear that no subject matter was surrendered. The Previous Examiner had pointed out indefinite phrases in the Claim as originally drafted and the original attorney amended the claim to clarify and remove the indefinite phrases which did not surrender subject matter and if anything, removed limitation and broadened the Claim. There has been no surrender and the recapture rule will not be violated by allowing all pending Claims. “The recapture rule does not apply in the absence of evidence that the applicant’s amendment was ‘an admission that the **scope** of the claim was not in

⁵ Attached herewith as Exhibit “B”.

fact patentable.” *Clement*, 131 F.3d 1469 (emphasis added).

However, the Current Examiner points to the comments of the Previous Examiner and asserts that the applicant surrendered by way of silence. Attention is drawn to M.P.E.P.⁶ which requires that the “omitted limitation was originally **argued** in the original application to make the application claims allowable over a rejection or objection made in the application.” Here there is no evidence of any arguments made prior to or after the purported “surrender” of subject matter. The only statements in the file wrapper are the Examiner’s remarks stating:

no prior art of record teaches or fairly suggest, alone or in combination, a cover having a plurality of panel units connected together in vertical spaced relationship at their ends, a plurality of grommets disposed at the connected ends, a cable disposed through each the entire row of loops⁷.

Applicant had nothing to argue since the statement as written is true. The Current Examiner, however, takes the position that the only Claims that could be allowable must contain all of the limitations set out above. This simply is not true and the Previous Examiner never made such a statement. The new Claims presented in the reissue application were never presented to the Previous Examiner and therefore were neither considered nor **argued** in the original application.

The Current Examiner asserts that the Previous Examiner made a statement as to what would not be allowable. Reading through the record, no support can be found for the Current Examiner’s position. The Previous Examiner merely stated that a claim having certain limitations is allowable and counsel had nothing with which to take issue. The Previous Examiner was silent

⁶ M.P.E.P § 1412.02 and the paragraph titled “Criteria for Determining that Subject Matter has Been Surrendered” (emphasis in the original)

⁷ Paper 2, Page 2, Paragraph 2 of the Previous Examiner, Attachment to Paper 17 of the current application, and Exhibit “B.”

as to removal or replacement of which limitations would make the claim non-allowable. The Current Examiner then uses the silence of the attorney in response to the silence of the Examiner to find surrender. The law under § 251 does not require attorneys to argue with statements that were never made to avoid surrender. Moreover, such alleged failure would merely provide that the attorney made an inadvertent error in not understanding the full scope of the invention and re-issue should be granted. *Hester*, 131 F.3d. At 1479-80.

In this case, where the underlying basis for the reissue application is that the previous attorney did not comprehend the invention, it is patently absurd to expect one without comprehension of the invention to be required to argue his incomprehension. Accordingly, applicant submits allowance of all pending claims does not violate the recapture rule and therefore requests allowance of all pending claims..

ANGENEHM LAW FIRM, Ltd.

By 

N. Paul Friederichs, Reg. No. 36,515

P.O. Box 48755

Coon Rapids, MN 55448

Telephone: 952 933-3225

Facsimile: 952 933-1285

(9) **Appendix:**

The Claims as currently presented:

1. A pond cover comprising:

a plurality of panel units linked together;

means for insulating said pond cover, said insulating means comprising a generally rectangular layer of insulation wherein each of said panel units is filled internally with said layer of insulation and is sealed at either end and along either side by welding; and

means for linking said panel units together and securing said pond cover in position on a pond, said linking means comprising grommets disposed along said sealed end of each of said panel units, and each of said panel units is linked in vertical spaced relationship to an adjacent panel unit by at least one cable disposed through said vertical spaced grommets and formed into a loop projecting above said panel units, and said securing means including a second cable which is disposed through an entire row of said loops and is anchored at either of its end to an anchoring means.

2. The pond cover of claim 1 wherein the loops disposed through the grommets project both above and below the panel units.

3. The pond cover of claim 1 wherein the loops disposed about the second cable are disposed through said grommets.

4. A pond cover comprising:

a plurality of panel units linked together;

means for insulating said pond cover, said insulating means comprising a generally rectangular layer of insulation wherein each of said panel units is filled internally with said layer of insulation and is sealed at either end and along either side by welding; and

means for linking said panel units together and securing said pond cover in position on a pond, said linking means comprising grommets disposed along said sealed end of each of said panel units, and each of said panel units is linked in vertical spaced relationship to an adjacent panel unit by at least one cable disposed through said vertical spaced grommets and formed into a loop projecting above said panel units, and said securing means including a second cable which is disposed through a row of said loops and is anchored at either of its end to an anchoring means.

5. A pond cover comprising:

a plurality of panels; and

means for linking and de-linking the panels comprising openings defined in the panels and substantially oval-shaped loops interconnecting the adjacent panels through adjacent openings in the panels.

6. The pond cover of claim 5 wherein the panels are rectangular.
7. The pond cover of claim 5 wherein the panels are formed of a geomembrane.
8. The pond cover of claim 5 wherein the panels are approximately seven and one-half feet wide and approximately forty feet long.
9. The pond cover of claim 5 further comprising:
means for controlling temperature.
10. The pond cover of claim 9 wherein the means for controlling temperature comprises:
insulation material sealed inside the panels.
11. The pond cover of claim 10 wherein the insulating material is sealed inside the panels by a weld.
12. The pond cover of claim 9 wherein the means for controlling temperature comprises:
a rectangular layer of insulation.
14. The pond cover of claim 5 wherein the means for linking further comprises:
grommets circumscribing the openings.
15. The pond cover of claim 5 wherein the openings are adjacent to edges of the panels.
16. The pond cover of claim 5 wherein the openings of adjacent panels are in a vertical spaced relationship.
18. The pond cover of claim 5 further comprising:
means for locking and unlocking the substantially oval-shaped loops relative to the openings in the panels.
19. The pond cover of claim 5 further comprising:
means for anchoring the cover in a desired position.
20. The pond cover of claim 19 wherein the means for anchoring comprises:
at least one tie-down cable; and
means for anchoring the tie-down cable.
21. The pond cover of claim 19 wherein the anchoring means comprises an anchoring trench.
22. The pond cover of claim 20 wherein the tie-down cable interacts with the means for linking.
23. The pond cover of claim 5 wherein the means for linking joins the panels in a partially

overlapping relationship.

24. The pond cover of claim 5 wherein the cover is supported above aqueous solutions.
25. The pond cover of claim 5 wherein the cover is a waste treatment pond cover.
26. The pond cover of claim 5 wherein the means for linking and de-linking the panels, includes an elongated member which passes through an opening in at least one panel.
27. The pond cover of claim 5 wherein the cover overlies a tank.
28. A method of manipulating a pond cover comprising the steps of:
forming a plurality of panels defining openings;
linking adjacent panels through adjacent openings with at least one loop, the loop
being oval-shaped; and
de-linking the plurality of panels.
29. The method of claim 28 wherein the step of forming further comprises the step of:
forming rectangular panels.
30. The method of claim 29 wherein the step of forming further comprises the step of:
forming panels that are approximately seven and one-half feet wide and
approximately forty feet long.
31. The method of claim 28 wherein the step of forming further comprises the step of:
forming a plurality of panels from a geomembrane.
32. The method of claim 28 wherein the step of forming further comprises the step of:
insulating the panels.
33. The method of claim 32 wherein the step of insulating further comprises the step of:
sealing insulation inside the panels.
34. The method of claim 33 wherein the step of sealing further comprises the step of:
welding the insulating material inside the panels.
35. The method of claim 32 wherein the step of insulating further comprises the step of:
insulating with a rectangular layer of insulation.
36. The method of claim 28 wherein the step of linking further comprises the steps of:
defining openings in the panels; and
interconnecting the openings.
37. The method of claim 28 wherein the step of forming further comprises the step of:

circumscribing the openings with grommets.

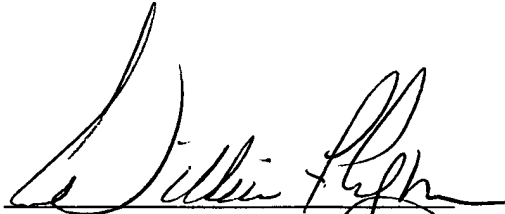
38. The method of claim 28 wherein the step of forming further comprises the step of:
defining the openings adjacent to edges of the panels.
39. The method of claim 28 wherein the step of linking further comprises the step of:
orienting the openings of adjacent panels in a vertical spaced relationship.
40. The method of claim 28 wherein the step of linking further comprises the step of:
inserting a cable through at least one loop forming at least one fastener.
41. The method of claim 40 wherein the step of linking further comprises the step of:
locking and unlocking the loop relative to the openings in the panels.
42. The method of claim 28 further comprising the step of:
anchoring the cover.
43. The method of claim 42 wherein the step of anchoring further comprises the step of:
anchoring the cover with an anchoring trench.
44. The method of claim 42 wherein the step of anchoring further comprises the step of:
anchoring the cover with at least one tie-down cable.
45. The method of claim 40 further comprising the step of:
anchoring the cover with at least one tie-down cable, the tie-down cable passing
through at least one fastener.
46. The method of claim 28 wherein the step of linking further comprises the step of:
orienting the panels in a partially overlapping relationship.
47. The method of claim 28 further comprising the step of:
supporting the cover above aqueous solutions.
48. The method of claim 28 wherein the step of linking further comprises the step of:
linking the panels together to cover a waste treatment pond.



CERTIFICATE OF MAILING, EXPRESS MAIL

I, the undersigned, hereby certify that the foregoing documents are being deposited with the United States Postal Service as, Express Mail, postage prepaid, in an envelope addressed to Commissioner of Patents and Trademarks, Washington, DC 20231 on this 18th day of May, 2000.

1. Appeal brief (11 pg.) with attached Exhibits in triplicate.
3. Certificate of Mailing (1 pg.)
4. Return Postcard
5. Check for \$155.00


William Flynn

EFG366648519US
Express Mail No.

June 13, 2001
Date

Applicant: William D. Morgan
For: Insulated Removable Pond Cover
Serial No.: 08/828,330
Docket No.: I 852-002-PAT
Date Filed: March 28, 1997